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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,159	10/16/2001	Walter Bernard Hill JR.	3597-129	3935

7590

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EXAMINER

CHEUNG, WILLIAM K

ART UNIT

PAPER NUMBER

1713

8

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/978,159

Applicant(s)

HILL ET AL.

Examiner

William K Cheung

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 29,30 and 40-45 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-28,31-33,38,39 and 46 is/are allowed.
- 6) ☒ Claim(s) 34-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. In response to the Election Response (Paper No. 7) filed May 21, 2003, the Group II restriction requirement set forth from Paper No. 6 is withdrawn. Therefore, the invention of Group II is rejoined to Group I. The Group III invention can not be rejoined because the Group I aqueous composition has lost its identity when converted into the Group III invention. Although applicants argue that the examination of Group III would not burden the examiner, however, the examiner disagrees because in view of the lost of identity of Group I invention when converted to Group III invention which is patentably distinct from the invention of Group I. Claims 1-46 are pending. Claims 29-30, 40-45 are drawn to non-elected claims.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Cassella, Jr. (US 3,784,400).

*The invention of claims 34-36 relates to a leather-treating composition comprising at least one hydrocarbon-substituted carboxylic acid anhydride or the alkali acid salt thereof.*

Cassella (abstract; col. 3, line 63 to col. 4, line 40) disclose a composition useful for leather treatment containing alkenyl succinic acid or succinic acid anhydride (hydrocarbon-substituted carboxylic acid anhydride), sulfated fatty oil (sulfated sperm oil, Hydrol 80, a fatty alcohol), an amide (col. 4, line 22-25), and water (col. 4, line 28). Since Cassella contains all the claimed limitations of claims 34-36, claims 34-36 are anticipated.

4. Claim 37 is rejected under 35 U.S.C. 102(b) as being anticipated by Birkhofer et al. (US 5,433,752).

*The invention of claim 37 relates to a leather-treating composition comprising an aqueous solution of an alkaline salt of an alphaolefin substituted-maleic acid copolymer or an alkali salt of a styrene-maleic acid copolymer.*

Birkhofer et al. (col. 6, line 54 to col. 9, line 20) disclose a composition containing MA/styrene copolymer (col. 8-9, examples 7, 8, 18, 20). Birkhofer et al. clearly indicate that the composition is aqueous (col. 7, line 25) and alkaline (col. 8, line 34). Because

Art Unit: 1713

Birkhofer et al. contain all the limitations of claim 37, the invention of claim 37 is anticipated.

### ***Allowances***

5. Claims 1-28, 31-33, 38-39, 46 are allowed.

6. The following is an examiner's statement of reasons for allowance:

As of the date of this office action, the examiner has not located or identified any reference that can be used singularly or in combination with another reference including the closest prior art of Cassella, Jr. (US 3,784,400) and Birkhofer et al. (US 5,433,752) to render the present invention anticipated or obvious to one of ordinary skill in the art.

*The invention of claims 1-28, 31-33, 38, 39, 46 relates to a composition comprising:*

- a) at least one hydrocarbon-substituted carboxylic acid anhydride or the alkali salt thereof;*
- b) at least one aliphatic acid amid;*
- c) caustic soda;*
- d) at least one C<sub>12</sub> or higher fatty alcohol;*
- e) at least one C<sub>10</sub> or lower alcohol cosolvent;*
- f) at least one preservative; and*

Art Unit: 1713

g) *water.*

The closest prior art Cassella (abstract; col. 3, line 63 to col. 4, line 40) discloses a composition useful for leather treatment containing alkenyl succinic acid or succinic acid anhydride, sulfated fatty oil (sulfated sperm oil, Hydrol 80, a fatty alcohol), an amide (col. 4, line 22-25), and water (col. 4, line 28). However, Cassella is silent on a composition containing at least one C<sub>10</sub> or lower alcohol cosolvent and a caustic soda. Since the composition of Cassella (col. 6, line 17-18) teaches a composition having a pH in the range of about 3 to 5.5, it would not be apparent to one of ordinary skill in art to use the composition teachings of Cassella to obtain the invention of claims 1-28, 31-33 which involves using a caustic soda in the disclosed composition.

The closest prior art Birkhofer et al. (col. 6, line 54 to col. 9, line 20) disclose a composition containing MA/styrene copolymer (col. 8-9, examples 7, 8, 18, 20). However, Birkhofer et al. are silent on a composition containing an aliphatic acid amide. Therefore, it would not be apparent to one of ordinary skill in art to use the teachings of Birkhofer et al. to obtain the invention of claims 38, 39, 46.

In view of the reasons set forth above, the invention of claims 1-28, 31-33, 38, 39, 46 is allowed.

**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (703) 305-0392. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5885 for regular communications and (703) 305-5885 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-

0661.



William K. Cheung

June 16, 2003